

Application No.: 10/578,792

Response Dated: January 13, 2011

Reply to Office Action Dated: October 13, 2010

REMARKS

Claim 1 has been amended to recite that the appropriate bulky (sterically demanding) substituents are "selected from the group consisting of 2-(4-diethylamino-2-hydroxy-benzoyl)-benzoic acid hexylester, 4-methyl benzylidene camphor, 3-benzylidene camphor, homosalate, benzylidene camphor sulfonic acid, methylene bis-benzotriazo tetramethylbutylphenol, drometrizole trisiloxane, and camphor benzalkonium methosulfate." Support for this amendment is found in the specification at, e.g., page 9, the last four lines to page 10, the first three lines (published International Application WO 2005/048960 is referenced); and original claim 5. See, e.g., *In re Gardner*, 177 USPQ 396, 397 (CCPA 1973) and MPEP §§ 608.01(o) and (l).

Claim 1 has also been amended to delete the parenthetical "(sterically demanding)" between the words "bulky" and "substituents." Support for this amendment is found in the specification at, for example, page 3, lines 9-12, lines 16-17, and line 27, page 9, fourth line from the bottom, page 10, lines 5-6 and lines 8-10; and original claim 5. *Id.*

Claims 4 and 5 have been canceled without prejudice.

Claims 8-11 have been withdrawn. Because of the Examiner's objection (addressed below) to claims 8, 9, and 11, these withdrawn claims have been amended. In particular, claims 8, 9, and 11 have been amended to delete the parenthetical "(25°C)". Support is found in the specification at, for example, page 3, fourth paragraph, page 4, lines 13- 20.

No new matter has been added by any of the amendments.

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Restriction Requirement

On page 2 of the Office Action (Paper No. 20101008), the Examiner issued a two-way restriction pursuant to 35 USC §§ 121 and 372. The restriction divided the claims into the following allegedly distinct inventions:

Group I drawn to "a light protecting composition" containing claims 1-7; and Group II drawn to "a method to increase the ratio of SPF to UV filter amount" containing claims 8-11. (*Id.*).

In issuing the restriction requirement, the Examiner asserted that "[t]he groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: [t]he polysiloxane compounds claimed are known, see EP979645, and therefore there is no special technical feature." (*Id.*).

As indicated by the Examiner, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7, during a telephone conversation between the Examiner and Kevin Hooper, on September 27, 2010. (*Id.*).

The telephonic election of Group 1, claims 1-7, with traverse is hereby affirmed.

Claim Objections

Claims 1, 4, 8, 9, and 11 were objected to because of alleged informalities. (*Id.* at 3).

In making the objection, the Examiner asserted that "[s]aid claims contain

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words and phrases in parentheses, i.e. claims 1 and 4 (sterically demanding), claims 8, 9, and 11 (25°C)." (*Id.*).

To forward prosecution in the application, claims 1, 8, 9, and 11 have been amended to delete the Examiner's noted parentheticals. Claim 4 has been canceled without prejudice.

It is submitted that the objections have now been rendered moot. Reconsideration and withdrawal of the objections are requested.

Indefiniteness Rejection

Claim 4 has been rejected under 35 USC § 112, as indefinite. (*Id.* at 3-4).

In making the rejection, the Examiner asserted that "claim 4 recites the broad recitation 'camphor or silyl residues', and the claim also recites 'such as 2-methyl. . . ' which is the narrower statement of the range/limitation." (*Id.* at 4).

To forward prosecution in the application, claim 4 has been canceled without prejudice.

It is submitted that the rejection has now been rendered moot. Reconsideration and withdrawal of the rejection are requested.

Anticipation Rejection

Claims 1-7 have been rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 979 645 to Gozenbach *et al.* ("Gozenbach"). (*Id.* at 5).

For the reasons set forth below, the rejection, respectfully is traversed.

Gozenbach discloses cosmetic light-screening compositions containing 2-phenylbenzimidazol-sulfonic acid (PBSA) or a salt thereof and a polysiloxane compound

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(page 9, Ins. 55-57). Gozenbach further discloses that this combination of the polysiloxane compound and PBSA or a salt thereof may optionally be used in combination with other known UV-A and/or UV-B filters (page 6 at [0026]). As suitable UV-B filters and UV-A filters, a large laundry list of compounds is disclosed belonging "to the widest classes of substance" ([0027] and [0029]).

In making the rejection, the Examiner summarily asserted that Gozenbach discloses "light screening compositions comprising the same polysiloxane-based UV filters as claimed in claims 1, 2, and 3, (page 1-5), the same additional UV filters as claimed in claims 1, 4, 5, and 6, (phenylbenz-imidazole sulfonic acid and 3-benzylidene camphor) (page 6), a carrier (aqueous phase and fatty phase) (abstract), as claimed in claim 1, and percentages of said polysiloxane-bases UV filter and UV filters which read on the ratio of claim 7 (claim 8)." (Paper No. 20101008 at 5).

As is well settled, anticipation requires "identity of invention." *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference **and arranged as in the claim**. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984). "Moreover, it is incumbent upon the Examiner to **identify where each and every facet** of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the disclosure in the reference "**by page and line**" upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

As discussed above, to forward prosecution in the present application, independent claim 1 has been amended to recite "... at least one additional UV filter which chromophore contains appropriate bulky substituents selected from the group consisting of 2-(4-diethylamino-2-hydroxy-benzoyl)-benzoic acid hexylester, 4-methyl benzylidene camphor, 3-benzylidenecamphor, homosalate, benzylidenecamphor sulfonic acid, methylene bis-benzotriazo tetramethylbutylphenol, drometrizole trisiloxane, and camphor benzalkonium methosulfate,"

The rejection fails to identify where in Gozenbach a light protecting composition as currently claimed is disclosed or suggested. The Examiner refers **generally** to the disclosure of Gozenbach, which discloses compositions containing a polysiloxane compound and 2-phenylbenzimidazole sulfonic acid. (Paper No. 20101008 at 5). However, 2-phenylbenzimidazole sulfonic acid is not a UV filter compound having a chromophore with bulky substituents. The Examiner's general citation to pages 1-6 of Gozenbach fails to account for the presently claimed invention, which recites **eight** specific additional UV filters having a chromophore with bulky substituents.

"[R]ejections under 35 U.S.C. § 102 are proper only when the claimed subject matter **is identically disclosed or described** in 'the prior art.'" *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). Thus, an anticipatory reference under 35 U.S.C. § 102 "**must clearly and unequivocally disclose** the claimed [subject matter] or direct those skilled in the art to the [claimed subject matter] without any

need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.* (emphasis added).

In order to arrive at the presently claimed invention, based on the disclosure of Gozenbach, first a selection has to be made with respect to the optionally present UV filters. (Gozenbach, page 6). Thus, this optional UV-filter must first be present. Secondly, a specific class of substances listed has to be selected from the many different classes of additional UV-filters disclosed in Gozenbach without any guidance from Gozenbach, which class of additional UV-filters might provide a synergistic effect. (*Id.*). Further, Gozenbach does not disclose such a synergistic effect is obtained with a polysiloxane for any of the many classes of additional UV-filters mentioned. However, even if these selections are made from the broad disclosure of Gozenbach, which the Examiner has not even contended, a further selection has to be made, namely within the selected class of additional UV-filters the specific UV-filters to which the presently amended claim 1 is restricted must be selected.

Because Gozenbach fails to "clearly and unequivocally disclose the claimed compo[sition]," Gozenbach is not a proper anticipatory reference. *Arkley*, 455 F.2d at 587.

In view of all of the foregoing, it is submitted that each and every element as recited in the amended claims is not present in Gozenbach. Accordingly, the rejection has been rendered moot. Reconsideration and withdrawal of the rejection are requested.

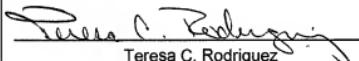
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For the foregoing reasons, entry of the amendments and allowance of the claims are respectfully requested. If the Examiner has any questions, please contact the undersigned.

I hereby certify that this correspondence is being transmitted in accordance with 37 CFR §§1.6(a)(4) and 1.8 via the U.S. Patent and Trademark Office (USPTO) electronic filing system (EFS-Web) to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 13, 2011.



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